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09/769,148	01/25/2001	Spencer A. Rathus	660-028	8428

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Ward & Olivo
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EXAMINER

KIM, AHSHIK

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 08/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/769,148

Applicant(s)

RATHUS ET AL.

Examiner

Ahshik Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04/17/03 (Amdt & TD).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 168-293 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 168-293 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Amendment

1. Receipt is acknowledged of the amendment filed on April 17, 2003. In the amendment,
5 claims 176, 201, 253, 272-274, 280-288, 290, 291, and 293 were amended. Currently, claims
168-293 remain for examination.

Terminal Disclaimer

2. The terminal disclaimer filed on April 17, 2003 disclaiming the terminal portion of any
10 patent granted on this application, which would extend beyond the expiration date of US Patent
No. 5,932,863 to Rathus et al. has been reviewed and is accepted. The terminal disclaimer has
been recorded (Paper #9).

Claim Rejections - 35 USC § 103

15 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
obviousness rejections set forth in this Office action:

20 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
such that the subject matter as a whole would have been obvious at the time the invention was made to a person
having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the
manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the
claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various
25 claims was commonly owned at the time any inventions covered therein were made absent any
evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

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the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 168-180, 183-185, 202-203, 228-251, 256, 259-262, 267-269, 272, 283, 288 and
5 290-293 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall et al. (US 4,488,035, "Withnall" hereinafter) in view of Fields (US 4,481,412) and Nobles et al. (US 4,820,167, "Nobles" hereinafter).

Re claims 168-180, 183-185, 202-203, 228-251, 256, 259-262, 267-269, 272, 283, 288,
and 290-293: Withnall discloses a system for displaying information to a user comprising a
10 printed document, which is a travel ticket (e.g., train, bus, etc.) having at least one machine
recognizable feature (i.e., barcode); a feature recognition unit 18 having associated therewith a
means for recognizing the machine recognizable feature (col. 4, lines 2-30); display the
information on the portable handset illuminated display having a microprocessor with
programmable memories (col. 5, lines 10-17).

15 Withnall fails to teach or fairly suggest that the displayed information is programming
material and the system further comprising means for transmitting a coded signal in response to
the recognition of the machine recognizable feature and an intelligent controller having
associated therewith a means for accessing the programming material in response to receiving
the coded signal.

20 Fields teaches the above limitation with an accessing means 10 having a microcontroller
23 including a barcode electronic circuit 25 electrically coupled to the barcode reader 24 for
transmitting/accessing the programming material in response to receiving the coded signal (fig.

2; col. 7, line 40 through col. 8, line 11); wherein the displayed data is a video/image/programming/sound/pictorial/electronic/media data and wherein the display 22 is a television/workbook (col. 6, lines 56-64 and col. 8, line 12 through col. 9, line 55).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Fields into the teachings of Withnall in order to provide Withnall with a higher technology system wherein the user being provided with a full complete information in a flexible ways (i.e., video, pictorial, etc.). Furthermore, such modification would have been an obvious extension as taught by Withnall, and therefore an obvious expedient.

Withnall as modified by Fields fails to teach or fairly suggest that the information comprises information related to a textbook.

Nobles teaches the above limitation with an electronic textbook 23 for receiving and transmitting test questions/answers, etc. (figs. 1-10; col. 4, line 55 through col. 13, line 18).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Nobles into the teachings of Withnall/Fields in order to provide Withnall/Fields with a more user-friendly system wherein the students do not have to be concerned about carrying a heavy bag of hardcopy textbooks, and they can retrieve their desired information that is related to their study readily through the electronic textbook/device. Furthermore, such modification would have been an obvious extension as taught by Withnall/Fields, and therefore an obvious expedient.

4. Claims 181, 182, 187, 188, 190, 196, 197, 199, 200, and 221-227 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall as modified by Fields and Nobles as applied

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to claim 168 above, and further in view of Roberts (US 5,324,922) and Malec et al (US 5,287,266). The teachings of Withnall as modified by Fields and Nobles have been discussed above.

Re claims 181, 182, 187, 188, 190, 196, 197, 199, 200 and 221-227:

- 5 Withnall/Fields/Nobles have been discussed above but fails to teach or fairly suggest feature for online/home shopping and the data link comprises a cable television line.

Roberts teaches the above limitation with a home/online shopping system (figs. 1-14; col. 1, lines 58+; col. 7, line 35 through col. 12, line 35).

- 10 It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Roberts into the teachings of Withnall/Fields/Nobles with a higher technology for a faster system due to the benefit of cable television transmitting capability. Furthermore, such modification would have been an obvious extension as taught by Withnall/Fields/Nobles to provide the user an alternative way of doing shopping (i.e., shopping online/at home), and therefore an obvious expedient.

- 15 Withnall/Fields/Nobles as modified by Roberts fails to teach or fairly suggest that the data link comprises an ISDN line.

Malec et al teaches the above limitation with the use of ISDN technology (col. 7, lines 1-12).

- 20 It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Malec et al into the teachings of Withnall et al/Fields/Nobles/Roberts in order to provide Withnall/Fields/Nobles/Roberts with the latest technology for a more accurate and faster system due to the benefit of ISDN networking lines.

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Furthermore, such modification would have been an obvious extension as taught by Withnall/Fields/Nobles/Roberts and would have been merely a substitution of equivalents (i.e., to cable television line) well within the ordinary skill in the art, and therefore an obvious expedient.

5 5. Claims 186, 189, 191, 193-195, 198, 201, 206-208, 210-211, 216-217, 220, 252-255, 257-258, 266, 271, 273-275, 286 and 289 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall as modified by Fields and Nobles as applied to claim 168 above, and further in view of Bravman et al (US 5,401,944). The teachings of Withnall as modified by Fields and Nobles have been discussed above.

10 Re claims 186, 189, 191, 193-195, 198, 201, 206-208, 210-211, 216-217, 220, 252-255, 257-258, 266, 271, 273-275, 286 and 289: Withnall/Fields/Nobles have been discussed above but fails to teach or fairly suggest that the displayed information including specific details related to traveling (e.g., seat location, departure terminal, hotel, restaurant, etc.), wherein the display unit comprising a wireless communication device (e.g., a remote unit).

15 Bravman et al teaches the above limitation with remote units 15 providing all necessary information related to traveling (i.e., seat assignment; airline/hotel/rental cars reservations, etc.) in col. 4, line 21 through col. 14, line 5 and col. 16, line 14 through col. 18, line 22.

 It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Bravman et al into the teachings of
20 Withnall/Fields/Nobles in order to provide Withnall/Fields/Nobles with a more flexibility system wherein the system is capable of providing the user all of his/her desired information about the trip/vacation that he/she is about to take, and thus providing a more user-friendly system.

Furthermore, such modification would have been an obvious extension as taught by Withnall/Fields/Nobles, and therefore an obvious expedient.

6. Claims 204, 209 and 212 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall as modified by Fields and Nobles as applied to claim 168 above, and further in view of
5 Anmelder (DT 2,452,202 A1). The teachings of Withnall as modified by Fields/Nobles have been discussed above.

Re claims 204, 209 and 212, Withnall/Fields/Nobles have been discussed above but fails to teach or fairly suggest that at least one machine recognizable feature is invisible.

Anmelder teaches the above limitation with the machine recognizable feature is invisible
10 (see English abstract).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Anmelder into the teachings of Withnall/Fields/Nobles in order to provide Withnall/Fields/Nobles with a more secure system wherein the data recorded in the machine recognizable feature is invisible to the naked eye, thus
15 preventing manipulating by a fraudulent user. Furthermore, such modification would have been an obvious extension as taught by Withnall/Fields/Nobles, and therefore an obvious expedient.

7. Claims 205 and 219 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall as modified by Fields and Nobles as applied to claim 168 above, and further in view of Tannehill et al (US 5,158,310). The teachings of Withnall as modified by Fields/Nobles have
20 been discussed above.

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Re claims 205 and 219, Withnall/Fields/Nobles have been discussed above but fails to teach or fairly suggest that at least one machine recognizable feature comprises a magnetic code/strip.

Tannehill et al teaches the above limitation with the machine recognizable feature can be
5 a barcode or a magnetic strip (col. 18, lines 7-12).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Tannehill et al into the teachings of Withnall/Fields/Nobles in order to provide Withnall/Fields/Nobles with an alternative feature for encoding data. Furthermore, such modification would have mere been a substitution of
10 equivalents well within the ordinary skill in the art, and therefore an obvious expedient.

8. Claims 213-215 and 218 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall as modified by Fields and Nobles as applied to claim 168 above, and further in view of Schach et al (US 5,397,156) and Anmelder (DT 2,452,202 A1). The teachings of Withnall as modified by Fields/Nobles have been discussed above.

15 Re claims 213-215 and 218, Withnall/Fields/Nobles have been discussed above but fails to teach or fairly suggest that at least one machine recognizable feature comprises a watermark.

Schach et al teaches the above limitation with a machine recognizable feature 42 comprises a watermark (see abstract).

It would have been obvious to an artisan of ordinary skill in the art at the time the
20 invention was made to incorporate the teachings of Schach et al into the teachings of Withnall/Fields/Nobles for its aesthetic purposes. Furthermore, such modification would have

been an obvious extension as taught by Withnall/Fields/Nobles, and therefore an obvious expedient.

Withnall/Fields/Nobles as modified by Schach et al fails to teach or fairly suggest that at least one machine recognizable feature comprises an invisible watermark.

5 Anmelder teaches the above limitation with the machine recognizable feature is invisible (see English abstract).

 It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Anmelder into the teachings of Withnall/Fields/Nobles/Schach et al in order to provide Withnall/Fields/Nobles/Schach et al with
10 a more secure system wherein the data recorded in the machine recognizable feature is invisible to naked eye, thus preventing manipulating by fraudulent user. Furthermore, such modification would have been an obvious extension as taught by Withnall/Fields/Nobles/Schach et al, and therefore an obvious expedient.

9. Claims 192, 263-265, 270, 271, 276-282, 284, 285 and 287 are rejected under 35 U.S.C.
15 103(a) as being unpatentable over Withnall as modified by Fields and Nobles as applied to claim 168 above, and further in view of Morales (US 5,872,589). The teachings of Withnall as modified by Fields/Nobles have been discussed above.

 Re claims 192, 263-265, 270, 271, 276-282, 284, 285 and 287: Withnall/Fields/Nobles have been discussed above but fails to teach or fairly suggest that the display unit comprises a
20 personal planner/phone/pager.

 Morales teaches the above limitation in figs. 2, 5, 8 & 9; col. 3, lines 28 through col. 7, line 12).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Morales into the teachings of Withnall/Fields/Nobles in order to provide the user with the flexibility of selecting his/her desired display unit that is fitting his/her needs, thus providing a more user-friendly system.

5 Furthermore, such modification would have been an obvious extension as taught by Withnall/Fields/Nobles, and therefore an obvious expedient.

Response to Arguments

10 10. As noted above, terminal disclaimer of US Patent 5,932,863 is accepted and entered. In doing so, Applicant overcame obviousness-type double patenting rejection issued by Examiner in previous Office Action.

15 With respect to the rejection under 35 U.S.C. 103(a), Applicant argues (See page 18, 2nd paragraph thereafter) essentially that the cited references in combination fail to specifically teach or fairly suggest the subject matter disclosed in instant application.

Although Applicants' embodiment may be different from disclosures shown in these references, it is Examiner's opinion that the cited references, in combination, teach the claimed invention of instant application. For example, claim 168 recites "A system for displaying
20 programming material to a user, the system comprising: a textbook having at least one machine recognizable feature; a feature recognition unit having associated therewith a means for recognizing said machine recognizable features and a means for transmitting a coded signal in response to the recognition of said machine recognizable feature; an intelligent controller having

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associated therewith a means for accessing said programming material in response to receiving said coded signal; and a display unit for presenting said programming material.” Other independent claims 288 and 293 recite similar methods (although scope of claim 288 seems broader than claim 293).

5 The Witnell patent discloses a printed matter having one machine recognizable feature such as barcode; a feature recognition unit; and a portable handset displaying information to the users. Without borrowing the subject matter disclosed in the Fields patent, it is Examiner’s view that travel information which can be retrieved once barcode on the ticket has been read can be considered programming material (see Withnall, col. 5, lines 14+) associated with the barcode.

10 It is further noted that Fields’ embodiment ’s teaches such markings are printed on a textbook (see claim 2); Nobles teaches the similar limitation with electronic textbook. In view of the above, it is Examiner’s position that one ordinary skill in the art would contemplate combining disclosed elements in the cited in order to improve or expand the functionality of textbook

 In response to applicant’s argument that there is no suggestion to combine the references,

15 the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.

20 1992). In this case, the primary reference to Withnall and the secondary references to Fields and Nobles are directed to a printed matter (i.e., tickets, textbooks, etc.) comprising an indicia, which is used for programming and further processing. Accordingly, it is Examiner’s view that the

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motivations, which are within one ordinary skill in the art, to improve the primary reference to Withnall have been provided.

Although double patenting rejection has been overcome, the claims are broadly recited such that the cited references, taken alone or in combination, teach the claimed invention.

5 Applicants' amendment and remarks describing these elements have been carefully studied and considered, but they are not persuasive. Therefore, Examiner has made this Office Action final.

10

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO
15 MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing
20 date of this final action.

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Tsukimi (US 5,495,459); Ohara et al. (US 5,739,814); Swartz et al. (US 6,095,418) disclose textbooks containing machine recognizable features. Cited references in this Action

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perhaps may provide embodiments similar to the subject matter envisioned in the instant application.

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (703)305-5203 . The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax number directly to the Examiner is (703) 746-4782. The fax phone number for this Group is (703)308-7722, (703)308-7724, or (703)308-7382.


Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Ahshik Kim
Patent Examiner
Art Unit 2876
July 31, 2003



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